

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 77209057

MARK: SULZER BINGHAM

77209057

CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Sulzer Management A.G.

CORRESPONDENT'S REFERENCE/DOCKET

NO:

SZB.411

CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated March 3, 2011 are maintained and continue to be final. *See* TMEP §§715.03(a), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §§715.03, 715.03(a), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. *See* TMEP §715.04(a).

For the reasons stated in previous Office Actions, the examining attorney finds that the specimen does not show use of the mark SULZER BINGHAM in connection with Class 37 pump repair and maintenance

services.

SPECIMEN DOES NOT SHOW USE OF THE MARK FOR CLASS 37

The specimen is not acceptable because it does not show the applied-for mark used in connection with “pump repair and maintenance services” specified in the statement of use. A statement of use must include a specimen showing the applied-for mark in use in commerce for each class of goods and/or services specified in the statement of use. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56(a), 2.88(b)(2); TMEP §§904, 1109.09(b).

After conducting another review of all the submitted specimens once again, the examining attorney has determined the following. The first specimen submitted in 2007 consisted of both a business card and an invoice. The only use of the mark SULZER BINGHAM appeared in the following sentence “*OEM parts and service for SULZER®, SULZER BINGHAM®, BINGHAM®, & JOHNSTON® pumps.*” The term SULZER BINGHAM identifies pumps, namely goods, not services, that are serviced or repaired by applicant.

The 2008 specimen consisted of an instruction and operation manual for pumps. The term SULZER BINGHAM appears as a trade name, namely SULZER BINGHAM INC. This is not service mark use, and neither is use of the term SULZER BINGHAM to identify pumps as goods.

Finally, the specimens submitted in the 2010 correspondence also fail. Again, the reference appearing in the business letter “*OEM parts and service for SULZER®, SULZER BINGHAM®, BINGHAM®, & JOHNSTON® pumps.*” is not service mark use. Then, applicant included a report and repair plan used with one of its clients. However, the repair plan also fails to show use of the mark SULZER BINGHAM as a source indicator for “pump repair and maintenance services.” Again, the only reference to SULZER BINGHAM is as part of the above-referenced phrase, which shows the term identifying pumps, not pump repair and maintenance services.

In this case, the specimens show use of the mark as the source identifier for goods, namely as the mark used in connection with pumps in Class 7. There is no indication that the Class 37 pump repair and maintenance services are identified by the mark SULZER BINGHAM. If anything, the term SULZER by itself is the source identifier for those services. Thus, there is no indication that the proposed mark is used to identify the services themselves. Prospective purchasers would clearly view SULZER BINGHAM as identifying the source of applicant’s pumps, but not perceive the mark as a service mark for Class 37 services.

Applicant’s argument merely relies on the reference to “*OEM parts and service for SULZER®, SULZER BINGHAM®, BINGHAM®, & JOHNSTON® pumps*” to insist that there is an association between the proposed mark and the Class 37 services fails. The phrase uses the proposed mark to identify pumps, also marketed under other trademarks, as shown in the phrase. The mere use of the words “service for” does not create an association between the mark and Class 37 services, but rather shows that SULZER BINGHAM is a source indicator for goods, namely pumps, related to the performance of services. In other words, the SULZER BINGHAM pumps are serviced, repaired and maintained by applicant. It has been established that a term that is used only to identify a product, device, or instrument sold or used in the performance of a service rather than to identify the service itself does not function as a service mark. *See In re Moody’s Investors Service Inc.*, 13 USPQ2d 2043 (TTAB 1989) (“Aaa,” as used on the specimen, found to identify the applicant’s ratings instead of its rating services); *In re Niagara Frontier Services, Inc.*, 221 USPQ 284 (TTAB 1983) (WE MAKE IT, YOU BAKE IT only identifies pizza, and does not function as a service mark to identify grocery store services); *In re British Caledonian Airways Ltd.*, 218 USPQ 737 (TTAB 1983) (term that identifies a seat in the first-class section of an airplane does

not function as mark for air transportation services); *In re Editel Productions, Inc.*, 189 USPQ 111 (TTAB 1975) (MINI-MOBILE identifies only a vehicle used in rendering services and does not serve to identify the production of television videotapes for others); *In re Oscar Mayer & Co. Inc.*, 171 USPQ 571 (TTAB 1971) (WIENERMOBILE does not function as mark for advertising and promoting the sale of wieners, where it is used only to identify a vehicle used in rendering claimed services).

A specimen for a service mark must show use of the mark “in the sale or advertising of services.” Trademark Act Section 45, 15 U.S.C. §1127; *see* 37 C.F.R. §2.56(b)(2); TMEP §1301.04. Indeed, “[w]hile the nature of the services does not need to be specified in the specimens, there must be something which creates in the mind of the purchaser an association between the mark and the service activity.” *In re Adair*, 45 USPQ2d 1211, 1215 (TTAB 1997) (quoting *In re Johnson Controls Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994)). There must be sufficient reference to the services in the specimen to create this association. *In re Monograms Am., Inc.*, 51 USPQ2d 1317, 1318 (TTAB 1999); *see* TMEP §§1301.04 *et seq.*

If the specimen does not show the mark with reference to, or association with, the services, the specimen fails to show service mark usage. *See In re Osmotica Holdings, Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010) (stating that “[a]t a minimum, the specimen must show a direct association between the services and the mark sought to be registered”); *In re DSM Pharms., Inc.*, 87 USPQ2d 1623, 1624 (TTAB 2008) (finding the mark must be used in a manner on the specimen so as to identify the applicant’s services and their source “via a direct association”).

Therefore, applicant must submit the following:

- (1) A substitute specimen showing the mark in use in commerce for each class of goods and/or services specified in the statement of use; and
- (2) The following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: “**The substitute specimen was in use in commerce prior to the expiration of the deadline for filing the statement of use.**” 37 C.F.R. §2.59(b)(2); TMEP §904.05; *see* 37 C.F.R. §2.193(e)(1). If submitting a substitute specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c); TMEP §904.05.

Examples of specimens for goods are tags, labels, instruction manuals, containers, photographs that show the mark on the actual goods or packaging, or displays associated with the actual goods at their point of sale. *See* TMEP §§904.03 *et seq.* Examples of specimens for services are signs, photographs, brochures, website printouts or advertisements that show the mark used in the actual sale or advertising of the services. *See* TMEP §§1301.04 *et seq.*

Pending receipt of a proper response, registration is refused because the specimen does not show the applied-for mark in use in commerce as a trademark and/or service mark for the identified goods and/or services. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56(a), 2.88(b)(2); TMEP §§904, 904.07(a). The request for reconsideration is denied.

Applicant may not withdraw the statement of use. 37 C.F.R. §2.88(g); TMEP §1109.17.

ADVISORY NOTE:

If applicant does not respond to this Office action within the six-month period for response, International Class(es) 37 will be deleted from the application. The application will then proceed with International Class(es) 7 only. *See* 37 C.F.R. §2.65(a); TMEP §718.02(a).

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